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10/661,812

09/15/2003

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EXAMINER

TRUONG, DUC

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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In re application of :  
Martin HEENEY et al. :  
Serial No. 10/661,812 :  
Filed: September 15, 2003 :  
For: MONO-, OLIGO-, and POLY(3-ALKYNYLTHIOPHENES) :  
AND THEIR USE AS CHARGE TRANSPORT :  
MATERIALS :

DECISION ON  
PETITION

This is a decision on the PETITION TO COMMISSIONER UNDER 37 CFR §1.181 FOR WITHDRAWAL OF RESTRICTION REQUIREMENT and FOR MODIFICATION OF THE IMPLEMENTATION OF THE ELECTION OF SPECIES REQUIREMENT.

On July 8, 2005, an office action was mailed containing a restriction requirement. The examiner required restriction between subcombination Group I (claims 1-15) and combination Group II (claims 16-27). The examiner further required restriction between the species recited in claim 14. On August 8, 2005 a response to the restriction requirement was submitted and species for examination were elected with traverse. On September 15, 2005 an office action was mailed. In the Office Action of September 15, 2005 the examiner also withdrew claims 7-9, 12 and 13 from consideration. A final Office Action was mailed on February 2, 2006.

On June 2, 2006 the instant petition was filed to formally request that the restriction requirement be withdrawn and that the Election of species requirement be properly applied to claims 9, 12 and 13. A duplicate petition was filed on November 30, 2007

**DECISION**

In the restriction requirement mailed June 8, 2005, the examiner identified Groups I and II as subcombination and combination respectively.  
MPEP 806.05(c) states:

**806.05(c) [R-5] Criteria of Distinctness Between Combination and Subcombination**

To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden if restriction were not required as evidenced by separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in another materially different combination.

When these factors cannot be shown, such inventions are not distinct.

In the instant application, several claims from the group II combination are dependent upon claim 1 which is included with the subcombination. For example, claim 19 recites:

19. A semiconductor or charge transport material, comprising a monomer, oligomer or polymer of claim 1.

Therefor it is clear that claim 19 (combination) requires the particulars of claim 1 (subcombination). In the original restriction requirement, the examiner stated "the combination as claimed does not require the particulars of the subcombination as claimed because the composition of Group I does not require the other components besides said monomer, oligomer or polymer of Group I." As the petition states, this argument incorrectly treats the monomer, oligomer or polymer as the combination. The restriction between Groups I and II as subcombination-combination is improper for this reason.

In the nonfinal rejection of September 15, 2005, the examiner withdrew claims 7-9, 12 and 13 from consideration as not being drawn to the elected species. No reason was given. Applicants traversed this holding in the response of December 1, 2005 providing reasons as to why claims 9, 12 and 13 read on the elected species. In the final rejection, the examiner responded to these arguments by stating:

"This is not convinced since the content of these claims, R4 and R5 denote P-Sp is optional component and is not required."

This statement appears to be incorrect as claim 9 requires one or both of R4 or R5 to be P-Sp. Further, the statement does not appear to clearly establish that claims 9, 12 and 13 do not belong to the elected species.

Accordingly, the restriction requirement as set forth in the office action of July 8, 2005 is improper and should be withdrawn. Further, claims 9, 12 and 13 should be examined with the elected species. The instant petition is **GRANTED**. The examiner is directed to withdraw the requirement and to examine claims 9, 12 and 13 with the elected species.



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